



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

29

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,733	10/03/2005	You-Ping Chan	022290.0122PTUS	8573
32042 7590 09/12/2007 PATTON BOGGS LLP 8484 WESTPARK DRIVE SUITE 900 MCLEAN, VA 22102			EXAMINER LUKTON, DAVID	
			ART UNIT 1654	PAPER NUMBER
			MAIL DATE 09/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,733

Applicant(s)

CHAN ET AL.

Examiner

David Lukton

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Pursuant to the response filed 7/5/07, several claims have been amended. Claims 1-25 remain pending.

Applicants' arguments filed 7/5/07 have been considered and found persuasive. The previously imposed rejections are withdrawn. Claims 15-25, previously withdrawn, are now rejoined.

At the present time, claim 1 is characterized as allowable.



The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-25 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 15 asserts that the tocopherol/oligomer conjugate is effective to "protect" plants. However, there is no evidence that this is the case. The term "protect" would imply that no group of insects, however determined, can cause any damage to a plant to which the conjugate has been administered. The term at issue might also imply protection

from adverse weather conditions such as drought, and freezing. However, there is no evidence that this is the case. (See also claim 24).

An issue separate from the foregoing concerns claim 19. This claim asserts that one can take a composition that has been formulated for protecting plants, and administer it to the eyes of a patient. Similarly, claim 19 asserts that one can take a composition that has been formulated for cosmetic purposes, and administer it to the cerebellum.

However, the specification does not teach the skilled artisan how to use the compositions in this way.



Claims 15-25 are objected to under 37 CFR 1.75(c) as being in improper form because multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP 608.01(n).

Claim 18 is objected to. The quotes around "small" are superfluous, at least in the context of a claim. The following phrase is suggested for claim 18:

wherein the active principle is a small organic molecule that is hydrophobic, hydrophilic or amphiphilic.



Claims 2-25 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 2 recites that the cationic species are “preferably” selected from metallic cations. The presence of this term raises questions about what other cations one can select from.
- In claim 8, the phrase “the glutamic units bearing grafts” lacks antecedent basis.
- Claim 11 is not properly subgeneric to claim 2. Claim 2 does not permit polyalkylene glycol groups to be present. Similarly, claim 12 is not properly dependent on claim 2. One option would be to cast claim 11 in independent form. Similar to the foregoing, claim 13 is not properly subgeneric to claim 1 or 2.
- Claim 15 is drawn to a composition that comprises one of the polyamino acids. As such, the claim is mandating the presence of another compound or mixture of compounds, yet provides no clues as to what the other compound(s) might be. Is it a carrier? Is it an active principle..? One option would be to replace claim 15 with the following (15R1 and 15R2):

15R1. A composition comprising a carrier in combination with one or more polyamino acids according to claim 1 or 2.

15R2. A composition comprising one or more polyamino acids according to claim 1 or 2, together with at least one active principle.

- Claim 15 asserts that the tocopherol/oligomer conjugate is effective to “protect” plants. The claim is indefinite as to what the plants can be protected from.
- In claim 17, the phrase “the active principle” lacks antecedent basis in claim 15.
- Claim 21 is drawn to a colloidal suspension that requires an aqueous phase. Claim 20, upon which claim 21 depends, permits the composition to be a “film”. How would applicants propose to prepare a composition which qualifies as a “film”, and which simultaneously qualifies as a colloidal suspension that contains an aqueous phase...?
- Claim 24 recites that the composition of claim 15 (or claims 16-23) is intended “for the preparation of” a medicinal product or a nutrient or a cosmetic or plant protection product. How is claim 24 different from claim 15 (or claims 16-23)...? If there is no physical difference, claim 24 is a “substantial duplicate” of claim 15. In any

case, claim 24 remains indefinite. For example, if one is in possession of a dietetic composition according to claim 15, what would one do to convert that into a "nutrient"...? Even more puzzling, if one is in possession of a plant protection composition according to claim 15, what would one do to convert that into a "medicinal product" for intracerebral administration...?

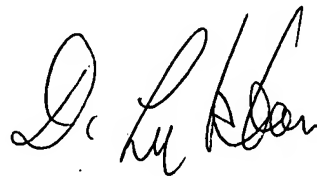
- In claim 24, 7th line from last, the term "possibly being" is used. However, this renders the claim indefinite as to whether the active principle is as described, or is not.
- In claim 24, the term "especially" (line 3 of text) is superfluous.
- In claim 24, 6th line from last, the phrase "for example... PEGylated proteins" is used. This phrase should be deleted from the claim, but another claim can be added which recites this phrase. See also claim 25.
- In claim 25, line 4, the term "possibly being" is used. However, this renders the claim indefinite as to whether the active principle is as described, or is not.
- In claim 25, the term "especially" (line 3 of text) is superfluous.
- Claim 25 recites (last two lines) that one uses a polyamino acid according to claims 15-23. However, none of these claims is drawn to a polyamino acid *per se*, but is drawn instead to a composition that comprises the polyamino acid. Perhaps dependence on claim 1 or 2 would be better.
- Claim 25 is indefinite as to the process steps intended. The claim recites only that one "uses" the compounds in question, but without stating how.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read 'D. Lukton', is positioned above the printed name.

DAVID LUKTON, PH.D.
PRIMARY EXAMINER